

REMARKS

Applicants have amended claim 168 to more accurately claim the present invention and have cosmetically amended claim 190 to address an informality. These amendments are not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the August 19, 2003 Office Action have been overcome and should be withdrawn.

Furthermore, Applicants are submitting herewith a terminal disclaimer to limit the term of the patent resulting from this application to that of Applicants' U.S. Pat. No. 6,164,534 (the "'534 patent"). Applicants want to bring the '534 patent to the Examiner's attention since the Examiner may believe that its claims are not patentably distinct from (or in fact encompass) the present invention. Claim 1 from the '534 patent is illustrative:

1. A system for displaying programming to a user, the system comprising:

a printed matter having at least one machine recognizable feature;

a feature recognition unit having associated therewith a means for recognizing said feature and a transmitter for transmitting a coded signal in response to the recognition of said feature;

an intelligent controller having associated therewith a receiver for receiving said coded

signal and means for accessing programming material; and

5 a display unit for presenting said programming material;

10 wherein said recognition unit, in response to the recognition of said feature, causes said intelligent controller to access said programming material and said display unit to execute or display said programming material.

I. THE INVENTION

Generally, the present invention is a system for
15 accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed travel ticket comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar
20 code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material
25 related to the printed travel ticket is displayed. Importantly, the present invention is designed to allow a user (e.g., a traveler) to access programming material related to the user's travel.

II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 168-178, 181-183, 200, 201, 225, 272-275, 280-282, 285, 296, 301, and 303-306 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature printed on a travel ticket to display travel information on the display of a portable handset. However, the Examiner admitted that:

"Withnall fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (August 19, 2003 Office Action, p. 3).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/

sound/pictorial/electronic/media data" on a "television/
workbook."

The Examiner stated that combining the systems
disclosed in Withnall and Fields would have been obvious at
5 the time of Applicants' invention:

10 "in order to provide Withnall with a higher
technology system wherein the user being provided
with a full complete information [sic] in a
flexible ways [sic]. . . .Furthermore, such
modification would have been an obvious extension
as taught by Withnall." (August 19, 2003 Office
Action, p. 4).

Also, the Examiner rejected claims 179, 180, 185, 186,
15 188, 194, 195, 197, 198, and 219-224 under 35 U.S.C. §
103(a) as being unpatentable over Withnall as modified by
Fields "as applied to claim[s] 168 and 301" in view of
Roberts U.S. Patent No. 5,324,922 (hereinafter referred to
as "Roberts") and Malec et al. U.S. Patent No. 5,287,266
20 (hereinafter referred to as "Malec"). The Examiner
admitted that Withnall and Fields fail to teach online or
home shopping and a cable television data link, and argued
that these features are disclosed by Roberts. According to
the Examiner, the combination of Roberts with Withnall and
25 Fields would have been obvious and would provide:

"a faster system due to the benefit of cable
television transmitting capability. Furthermore,
such modification would have been an obvious
extension as taught by Withnall/Fields to provide

the user an alternative way of doing shopping.”
(August 19, 2003 Office Action, pp. 4-5).

Moreover, the Examiner admitted that Withnall, Fields,
5 and Roberts all fail to disclose an Integrated Services
Digital Network (“ISDN”) data link which, according to the
Examiner, is disclosed by Malec. In the opinion of the
Examiner, the combination of Malec with Withnall, Fields,
and Roberts would have been obvious for providing:

10 “a more accurate and faster system due to the
benefit of ISDN networking line[s]. Furthermore,
such modification would have been an obvious
extension as taught by Withnall/Fields/Roberts
and would have mere[ly] been a substitution of
15 equivalents.” (August 19, 2003 Office Action, p.
5).

Next, the Examiner rejected claims 184, 187, 191-193,
196, 199, 204-206, 208, 209, 214, 215, 218, 226-271, 279,
20 284, 286-288, 299, and 302 under 35 U.S.C. § 103(a) as
being unpatentable over Withnall as modified by Fields “as
applied to claim[s] 168 and 301” in view of Bravman *et al.*
U.S. Patent No. 5,401,944 (hereinafter referred to as
“Bravman”). The Examiner admitted that Withnall and Fields
25 fail to teach displaying information comprising specific,
travel-related details on a wireless communication device.
According to the Examiner, Bravman teaches a remote unit
providing travel-related information, and the combination

of Withnall, Fields, and Bravman would have been obvious for providing:

5 "a more flexibility [sic] system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields."
10 (August 19, 2003 Office Action, p. 6).

Also, the Examiner rejected claims 202, 207, and 210 under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claims 168 and 301" in
15 view of Waterbury German Patent No. DE 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall and Fields fail to teach an invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted that the
20 combination of Waterbury with Withnall and Fields would have been obvious for providing:

25 "a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus preventing manipulating [sic] by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields." (August 19, 2003 Office Action, pp. 6-7).

30 Next, the Examiner rejected claims 203 and 217 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claims 168 and 301" in

view of Tannehill et al. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall and Fields fail to teach a magnetic code strip, which is argued to be taught by Tannehill.

5 According to the Examiner, the aforementioned combination would have been obvious for providing Withnall and Fields with an alternative method for encoding data. "Furthermore, such modification would have merely been a substitution of equivalents." (August 19, 2003 Office
10 Action, p. 7).

Additionally, the Examiner rejected claims 211-213 and 216 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claims 168 and 301" in view of Schach et al. U.S. Patent No. 5,397,156
15 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall and Fields fail to teach a watermark, which the Examiner asserted is taught by Schach. In the Examiner's opinion, the combination of Schach with "Withnall/Fields aesthetic purpose [sic]" would have been
20 obvious. "[S]uch modification would have been an obvious extension as taught by Withnall/Fields." (August 19, 2003 Office Action, p. 8).

The Examiner then admitted that Withnall, Fields, and Schach fail to teach an invisible watermark, which is

argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Schach, and Waterbury would have been obvious for providing:

5 "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Schach." (August 19, 10 2003 Office Action, p. 8).

Also, the Examiner rejected claims 190, 276-278, 283, 284, 289-295, 297, 298, and 300 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as 15 applied to claims 168 and 301" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall and Fields fail to teach a display unit comprising a "personal planner/phone/pager," which the Examiner asserted is taught 20 by Morales. In the Examiner's opinion, combining Withnall, Fields, and Morales would have been obvious to provide:

25 "the user with the flexibility of selecting his/her desired display unit that is fitting his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields." (August 19, 2003 Office Action, p. 9, paragraph 11).

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III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

The Examiner rejected claims 168-178, 181-183, 200-201, 225, 272-275, 280-282, 285, 296, 301, and 303-306 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Fields. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall and Fields. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall with Fields exists.

"Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d

1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would have been obvious
5 to combine the teachings of Withnall and Fields to arrive
at the various embodiments of Applicants' invention. Yet,
the Examiner has cited only purported benefits of this
combination without pointing to what motivation is provided
by the references themselves. Applicants submit that no
10 combination of these references would have been obvious to
one of skill in the art at the time of Applicants'
invention. Specifically, Withnall discloses a system for
utilizing barcodes on commuter tickets to test for
validity. The Examiner suggests that "travel information
15 which can be retrieved once barcode [sic] on the ticket has
been read can be broadly interpreted a[s] programming
material...associated with the barcode." (August 19, 2003
Office Action, p. 10) Applicants respectfully submit
however, that this does not constitute programming
20 material. The "travel information" referred to by the
Examiner is encoded within the barcode on the ticket. The
system of Withnall reads this information from the barcode,
it does not retrieve it from a separate database. The
barcode or the data encoded therein do not themselves
25 constitute programming material. Indeed, the only

interaction the barcode has with a database is a mere validity check, i.e., the comparison of data on the ticket to stored reference data.

5 This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. Fields relies on a read-only videodisc thereby sacrificing updatability and
10 flexibility. In fact, Fields does not even contemplate the ability to interface with a remote server or an updatable video source. Thus, there is no suggestion to combine a travel ticket verification system that does not provide programming material with a training system that
15 automatically cues to a certain frame on a videodisc. The mere fact that Fields and Withnall can use a barcode is an insufficient basis to suggest their combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a)
20 rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

10 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

15 Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

20 In addition to the lack of suggestion or motivation to combine Withnall and Fields, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses
25 a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means.

Fields discloses a system that reads a bar code on a training manual for playing corresponding material from a videodisc. Applicants respectfully submit that the combination of Withnall and Fields cannot be successfully
5 combined to disclose the means for accessing programming material associated with a database or the printed travel ticket having a machine recognizable feature of the claimed invention. Claims 301, 304, and amended claim 168 all disclose the accessing of programming material resulting
10 from recognition of a machine recognizable feature on a printed travel ticket. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the
15 associated information (or programming material) upon scanning a travel ticket. This is not possible with the combination of Withnall and Fields. Crucially, neither reference suggests anything remotely related to scanning a travel ticket and receiving programming information related
20 to the travel ticket (e.g., destination information, lodging information, etc.).

Furthermore, any attempt of implementing the videodisc player of Fields with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore,

every time information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new
5 videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not
10 substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such
15 material.

In view of the foregoing, claims 168, 301, and 304 cannot be unpatentable over Withnall and Fields. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base
20 claims. Therefore, these claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall and Fields combination regarding matter disclosed in dependent claims and appended

various other references including Roberts, Malec, Bravman,
Waterbury, Tannehill, Schach, and Morales to the
combination in order to provide the additional features of
the dependent claims. However, the combination of Withnall
5 and Fields has been shown to be not only improper, but also
to lack the disclosure of each and every element of the
base claims. Because this combination is improper and
incomplete, any further combining of references to Withnall
and Fields would also be improper. Thus, Applicants
10 respectfully submit that all remaining rejections have also
been overcome and should be withdrawn.

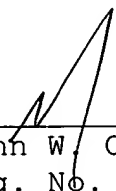
CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: _____

2/18/09



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